



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

# 12

In re Application of:  
Chen et al.

Serial No.: 09/728,038

Confirmation No.: 2584

Filed: December 1, 2000

For: Apparatus and Method  
for Controlling Delivery  
of Slurry to a Region of a  
Polishing Device

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Group Art Unit: 3723

Examiner: Grant, A.

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MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING 37 CFR 1.8	
I hereby certify that this correspondence is being deposited on August 15, 2003 with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
August 15, 2003 Date	 Gero G. McClellan

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
BASED ON FAILURE TO RECEIVE RESPONSE TO  
FINAL OFFICE ACTION UNDER MPEP 711.03(c)**

The above-identified application became abandoned on April 23, 2003. Applicants promptly filed a Petition to Withdraw Holding of Abandonment based on the PTO's misplacement of Applicants' Response to the Examiner's final office action under MPEP 711.03(c). The Applicants' Petition was denied. However, Applicants respectfully request that the decision be reversed for reasons of equity described below.

Applicants filed their response to the Examiner's final office action on Jan. 23, 2003 (i.e., three months prior to the expiration of the six month date). At the time of the filing Applicants believed the issues were well-defined and that an allowance was imminent, based on the prior communications with the Examiner, both written and oral. Accordingly, the Response contained no amendments to any pending claims, and added one new claim which was believed to have the same basis for allowance as the pending claims. Applicants' primary objective was that at least the pending claims be examined in light of the arguments made in the Applicants' response. Applicants

believed that by filing three months prior to the expiration of the six month date, sufficient time was available for any communications between the Applicants and the Examiner needed to place the claims in condition for allowance, including removing new claim 37, if necessary.

However, despite his best efforts, the Examiner could not locate the Applicants' response. (It was later determined that, while the PTO had received the response, it had been misplaced.) After numerous status inquiries made by the Applicants, and numerous attempts by the Examiner to locate the response, it became clear that the Examiner would not receive the response prior to the expiration of the six-month period. Accordingly, Applicants faxed a copy of the response to the Examiner two days prior to the expiration of the six-month period. Unfortunately, the Examiner's advisory action refusing entry of the response on grounds that the only new claim raised a new issue was not mailed until after the expiration of the six-month statutory period, resulting in abandonment of the application.

Applicants submit that, as a result of events not under their control, they were deprived of their opportunity to have the pending claims examined. Under normal circumstances, filing the response three months prior to the expiration of the statutory period provides ample time to determine if the claims are in condition for allowance. Through no fault of the Applicants or the Examiner, a misplaced document prevented such a determination, resulting in abandonment of the application before Applicants were informed that the response mailed January 23, 2003, raised a new issue.

Applicants recognize that the Decision on this petition supports the Examiner's conclusion that the new claim filed January 23, 2003, raises a new issue. However, Applicants were not informed that a new issue was raised until after the application was abandoned. Accordingly, Applicants respectfully request that the holding of abandonment be withdrawn for consideration by the Examiner of the arguments timely

presented for the pending claims, *i.e.*, claims 1-36, in the response filed on January 23, 2003, since the Applicants were effectively denied the opportunity to resubmit the response without the new claim.

Respectfully submitted,



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